

**Annemarie Franklin, Esq.** (CA Bar No. 150734)

E-mail: af102@nyc.rr.com

830 Broadway

P.O. Box 1024 Cooper Station

New York, NY 10276-1024

212-475-1630

7562 Ellis Avenue, Suite A5

Huntington Beach, CA 92648

917-686-7420

**Frederick H. Cohn**

E-mail: fcohn@frederickhcohn.com

61 Broadway, Suite 1601

New York, NY 10006

212-768-1110

Attorneys for Plaintiffs

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SERENDIP LLC & WENDY CARLOS,

Plaintiffs,

vs.

WARNER BROS. ENTERTAINMENT INC.,

Defendant.

WARNER BROS. ENTERTAINMENT INC.,

Counter-Claimant,

vs.

SERENDIP LLC,

Counter-Defendant.

Case CV08-07739 RGK (RCx)

**NOTICE OF LODGING  
OF UNPUBLISHED  
AUTHORITY IN SUPPORT  
OF MOTION TO DISMISS**

DATE: April 20, 2009

TIME: 9:00 a.m.

PLACE: Courtroom 850  
255 E. Temple St.  
Los Angeles, CA

1 TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

2 PLEASE TAKE NOTICE that a true copy of the unpublished authority cited  
3  
4 in the Memorandum of Points and Authorities in support of Counter-Defendant's  
5 Motion to Dismiss is being lodged with the Court.

6 Dated: February 26, 2009  
7

8 By \_\_\_\_\_ s/\_\_\_\_\_  
9 Annemarie Franklin  
10 Attorney for Plaintiff &  
11 Counter-Defendant  
12 Serendip LLC  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28



1 of 1 DOCUMENT

**GLADWELL GOVERNMENT SERVICES, INC., Plaintiff - Appellant, v. COUNTY  
OF MARIN; COUNTY OF TUOLUMNE, a legal subdivision of the State of  
California, Defendants - Appellees.**

No. 05-17327

**UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT**

*265 Fed. Appx. 624; 2008 U.S. App. LEXIS 2291; Copy. L. Rep. (CCH) P29,510*

**November 7, 2007, Argued and Submitted, San Francisco, California  
January 28, 2008, Filed**

**NOTICE:** PLEASE REFER TO FEDERAL RULES  
OF APPELLATE PROCEDURE RULE 32.1  
GOVERNING THE CITATION TO UNPUBLISHED  
OPINIONS.

**PRIOR HISTORY:** [\*\*1]

Appeal from the United States District Court for the  
Northern District of California. D.C. No. CV-04-03332-  
SBA. Sandra B. Armstrong, District Judge, Presiding.  
*Gladwell Governmental Servs. v. County of Marin*, 2005  
U.S. Dist. LEXIS 42276 (N.D. Cal., Oct. 15, 2005)

**DISPOSITION:** REVERSED AND REMANDED.

**COUNSEL:** For GLADWELL GOVERNMENT  
SERVICES, INC., Plaintiff - Appellant: Kevin D.  
Hughes, Los Angeles, CA.

For COUNTY OF MARIN, COUNTY OF  
TUOLUMNE, a legal subdivision of the State of  
California, Defendants - Appellees: Cary M. Adams,  
Esq., Geoffrey Alan Goodman, MURPHY AUSTIN  
ADAMS SCHOENFELD LLP, Sacramento, CA.

**JUDGES:** Before: HUG, THOMAS, and TALLMAN,  
Circuit Judges.

**OPINION**

**[\*625] MEMORANDUM \***

\* This disposition is not appropriate for  
publication and is not precedent except as  
provided by 9th Cir. R. 36-3.

Before: HUG, THOMAS, and TALLMAN, Circuit  
Judges.

Gladwell Government Services, Inc. ("Gladwell")

appeals the district court's dismissal of its copyright  
infringement action for failure to state a claim under *Rule*  
*12(b)(6)*. We reverse. Because the parties are familiar  
with the factual and procedural history of this case, we  
need not recount it here.

I

We review *de novo* a dismissal for failure to state a  
claim under *Rule 12(b)(6)*. *Knievel v. ESPN*, 393 F.3d  
1068, 1072 (9th Cir. 2005). At this stage, we take as true  
allegations of material [\*\*2] fact in the complaint and  
construe the pleadings in the light most favorable to the  
nonmoving party. *Id.* Our review is generally limited to  
the contents of the complaint, but we "may consider  
evidence on which the complaint 'necessarily relies' if:  
(1) the complaint refers to the document; (2) the  
document is central to the plaintiff's claim; and (3) no  
party questions the authenticity of the copy attached to  
the 12(b)(6) motion." *Marder v. Lopez*, 450 F.3d 445,  
448 (9th Cir. 2006). As the parties concede, we may  
consider the 1999 contract between Gladwell and Marin  
under the foregoing exception.

II

The central claim raised on appeal is that Gladwell  
had authored and obtained copyright protection in certain  
material ("Pre-Existing Materials") that pre-dated the  
Marin contract that resulted in the creation of the  
retention schedules ("Marin Schedules"). The Copyright  
Act provides that copyright ownership "vests initially in  
the author or authors of the [\*626] work." 17 U.S.C. §  
201(a). However, if the work is made "for hire," "the  
employer or other person for whom the work was  
prepared is considered the author . . . and, unless the  
parties have expressly agreed otherwise in a written  
instrument [\*\*3] signed by them, owns all of the rights  
comprised in the copyright." 17 U.S.C. § 201(b). *Section*  
*101 of the Copyright Act* defines a "work made for hire"



is "a work specially ordered or commissioned . . . if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire . . ." 17 U.S.C. § 101(2). The plain language of the statute indicates that a work-for-hire agreement cannot apply to works that are already in existence. Works "specially ordered or commissioned" can only be made after the execution of an express agreement between the parties. See *Playboy Enters., Inc. v. Dumas*, 53 F.3d 549, 558-59 (2d Cir. 1995); *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 412-13 (7th Cir. 1992) ("The writing must precede the creation of the property" to qualify as a work-for-hire agreement). Accordingly, Marin could not acquire copyright ownership in Gladwell's Pre-Existing Materials through a work-for-hire agreement.

Additionally, the agreement did not transfer Gladwell's copyright interest in the Pre-Existing Materials to Marin. The agreement provides that "[a]ll reports, information, data, work product, findings, and conclusions [\*\*4] furnished to or collected, prepared, assembled, and/or made by [Gladwell's agents] under this Agreement ('Work Product') shall be the property of [Marin]." This language by itself cannot operate to effect a copyright transfer as a matter of law. See 17 U.S.C. § 204(a) (requiring that a transfer of copyright ownership must be made in a signed writing); *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990). Transfer of a copyright interest must be made expressly. *Id.* ("The rule is really quite simple: If the copyright holder agrees to transfer ownership to another party, that party must get the copyright holder to sign a piece of paper saying so.").

Because Gladwell has alleged a protectable copyright interest in the Pre-Existing Materials that cannot be transferred except in conformity with the requirements of the Copyright Act, Gladwell has standing to sue for copyright infringement and has stated a claim for relief sufficient to withstand a motion to

dismiss on the pleadings.

### III

Although Gladwell has stated a claim sufficient to avoid a *Rule 12(b)(6)* dismissal, it is far from evident that it has a legitimate claim. The record is simply too undeveloped to make that conclusion. [\*\*5] It is unclear what, if anything, comprises the Pre-Existing Materials, and whether the Pre-Existing Materials or the Marin Schedules are, in fact, copyrightable -- that is, whether they involve the requisite "minimal degree of creativity" necessary for copyright protection. See *Feist Publ'ns, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340, 345, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991).

It is also unclear from the record whether the contract, setting aside the question of the Pre-Existing Materials, actually created a work-for-hire agreement as contemplated by the Copyright Act. The district court's determination was based on a misreading of several parts of the contract. For instance, the district court read the contract to provide that all work product "furnished to [Marin]" shall be the property of Marin, when in fact it states that all work product "furnished to [Gladwell]" shall be the property of Marin. Additionally, the district court reported that Gladwell [\*\*627] cannot "use or publish" the Marin Schedules without Marin's prior authorization, but the contract only prohibits Gladwell from publishing (or making available) the Marin Schedules without Marin's authorization.

All of these matters are committed to the careful [\*\*6] consideration of the district court on remand, and we express no opinion on any of these questions. Our holding simply is that Gladwell has standing to sue and its complaint survives the minimal requirements of *Rule 12(b)(6)*.

**REVERSED AND REMANDED.**